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REMARKS/ARGUMENTS

Claims 23-30 are pending in this application. Claim 30 has been withdrawn from further consideration as being directed to a non-elected species. By this Amendment, Applicant cancels Claims 10-17 and amends Claim 23.

Claims 10-17 have been canceled because these claims are directed to a non-elected species and are not dependent upon a generic claim. Applicant reserves the right to file a Divisional Application to pursue prosecution of non-elected Claims 10-17.

Claim 30 has not been canceled because Claim 30 is dependent upon generic Claim 23. Accordingly, Applicant respectfully requests that the Examiner rejoin and allow Claim 30 when generic Claim 23 is allowed.

Claims 23-27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kuroda et al. (U.S. 5,331,204). Claims 28 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuroda et al. in view of Takehara et al. (U.S. 2003/0071350). Applicant respectfully traverses the prior art rejections of Claims 23-29.

Claim 23 has been amended to recite:

A ceramic multilayer substrate comprising:

a ceramic laminate including a plurality of ceramic layers, having a first main surface, and including internal circuit elements disposed inside of the laminate;

a resin layer having a bonding surface in contact with the first main surface of the ceramic laminate and a mounting surface opposite to the bonding surface;

external electrodes, each disposed on the mounting surface of the resin layer and electrically connected to at least one of the internal circuit elements of the ceramic laminate; and

a ground electrode disposed inside of the resin layer; wherein

**the ground electrode is arranged to overlap at least one of the external electrodes in a direction of lamination of the plurality of ceramic layers.** (emphasis added)

The Examiner alleged that Kuroda et al. teaches all of the features recited in Claim 23, including the feature of a ground electrode 9 disposed inside the resin layer 2 as recited in Claim 23.

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Applicant's Claim 23 has been amended to recite the feature of "the ground electrode is arranged to overlap at least one of the external electrodes in a direction of lamination of the plurality of ceramic layers." Support for this feature is found, for example, in the second full paragraph on page 18 to the paragraph bridging pages 19 and 20 of the Substitute Specification and in Figs. 4 and 6 of the originally filed drawings.

In contrast to Applicant's Claim 23, the ground electrode 9 of Kuroda et al. does not overlap the external electrode 10. Thus, Kuroda et al. clearly fails to teach or suggest the feature of "the ground electrode is arranged to overlap at least one of the external electrodes in a direction of lamination of the plurality of ceramic layers" as recited in Applicant's Claim 23.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 23 under 35 U.S.C. § 102(b) as being anticipated by Kuroda et al.

In anticipation of the Examiner changing the rejection of Claim 23 to a rejection under 35 U.S.C. § 103(a) as being unpatentable over Kuroda et al., Applicant respectfully submits that it would not have been obvious to modify the integrated circuit package of Kuroda et al. such that the ground electrode 9 would have been arranged to overlap at least one external electrode as recited in Applicant's Claim 23.

Lines 32-37 of col. 3 of Kuroda et al. specifically disclose that "all the ground planes 9 within a region vertically under/above the conductor pad are deleted.... Consequently, no ground plane 9 exists within the region vertically under/above a conductor pad such as the connection pad 6 or the bonding pad 10." Thus, Kuroda et al. specifically teaches away from an arrangement in which the ground plane 9 is disposed in a region vertically under/above the bonding pad 10, i.e., an arrangement in which the ground plane 9 is arranged to overlap the bonding pad 10 in a direction of lamination of the plurality of ceramic layers 3a.

The Examiner is reminded that it is error to find obviousness where references diverge and teach away from the invention at hand. W.L. Gore & Assoc. v. Garlock Inc.,

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220 USPQ 303, 311 (Fed. Cir. 1983).

Therefore, it would clearly not have been obvious to modify the integrated circuit package of Kuroda et al. so as to include the feature of “the ground electrode is arranged to overlap at least one of the external electrodes in a direction of lamination of the plurality of ceramic layers” as recited in Applicant’s Claim 23.

The Examiner relied upon Takehara et al. to alleged cure deficiencies of Kuroda et al. However, Takehara et al. clearly fails to teach or suggest the feature of “the ground electrode is arranged to overlap at least one of the external electrodes in a direction of lamination of the plurality of ceramic layers” as recited in Applicant’s Claim 23. Thus, Applicant respectfully submits that Takehara et al. fails to cure the deficiencies of Kuroda et al. described above.

Accordingly, Applicant respectfully submits that Kuroda et al. and Takehara et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of features recited in Applicant’s Claim 23.

In view of the foregoing amendments and remarks, Applicant respectfully submits that Claim 23 is allowable. Claims 24-29 depend upon Claim 23, and are therefore allowable for at least the reasons that Claim 23 is allowable. In addition, Applicant respectfully requests that the Examiner rejoin and allow non-elected Claim 30.

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

To the extent necessary, Applicant petitions the Commissioner for a One-Month Extension of Time, extending to September 5, 2008, the period for response to the Office Action dated May 5, 2008.

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The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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